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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,730	11/02/2001	Kevin A. Seiling	01-180	2670

7590 10/22/2003
COHEN & GRIGSBY, P.C.
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Pittsburgh, PA 15222

EXAMINER

KUHNS, ALLAN R

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/001,730Applicant(s)
SEILING ET AL.Examiner
KUHNSGroup Art Unit
1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) ~~1-6 AND~~ 1-28 is/are pending in the application.
- ☐ Of the above claim(s) 6-17 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5 AND 18-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-28 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 18-28, drawn to a composition for use in structural members, classified in class 428, subclass 317.9.
- II. Claims 6-17, drawn to a method of making an extruded shape, classified in class 264, subclass 45.3.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as product (composition) and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (composition) as claimed can be used in a materially different process of using that composition such as one in which a shaped product is formed by injection molding rather than extrusion.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art requiring divergent fields of search for the respective inventions, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Frederick Tolhurst on October 1, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5 and 18-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are indefinite because it is initially stated in claim 1 that one of three polymers is to be selected, but then later in the claim it appears that polyvinyl chloride has been selected. Clarification is required.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 and 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohl. Kohl discloses the basic claimed composition for use in a structural member including polyvinyl chloride and glass fibers, the PVC being present at between 82-99% by weight and the glass fibers being present in an amount between 1 – 18% by weight (note column 3, lines 12-19). Kohl discloses or suggests the fibers being embedded in the foamed PVC. While Kohl appears not to explicitly state that the

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foam cells are closed, forming such a structure is well known and would have been obvious to one of ordinary skill in the art since there is no desire expressed by Kohl to produce an article which is porous to fluids.

Kohl teaches or suggests a glass fiber size within the ranges of claims 2-4 at column 3, lines 19-24, and it is submitted that the bulk density of the fibers of Kohl falls within the range of claim 5 since the material and sizing are as taught by Kohl. Concerning claim 18, it is the composition itself which is being evaluated, not the process steps used to formulate the composition. The blowing agents recited in claims 19-28 are well known and their use in the composition of Kohl would have been obvious to one of ordinary skill in the art in order to provide a driving force to form foam.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is 703-308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

Allan R. Kuhns
ALLAN R. KUHNS
PRIMARY EXAMINER AU 1732
10-15-03